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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,703	05/14/2001	John Muraca	1503.1002	6536
21171 7590 12/18/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER NGUYEN, TRAN N	
			ART UNIT 3626	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/853,703

Applicant(s)

MURACA, JOHN

Examiner

Tran Nguyen

Art Unit

3626

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-21, 23-35 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-21, 23-35 and 37-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

This communication is in response to the communication filed 10/17/2008.

Pending claim(s): 1-7, 9-21, 23-35, 37-42. Cancelled claim(s): 8, 22, 36, 43-44.

Amended claim(s): 1, 15, 29.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/2008 has been entered.

Response to Amendment

As per the warning of claim 44 under 37 CFR 1.75, this warning is hereby withdrawn in view of Applicant's cancellation of claim 44.

Claim Objections

Claims 2, 9-14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

As per claim 2, this claim recites "medical software executed by the hand-held device".

As discussed below, the "hand-held device" is not a structural limitation of the claimed apparatus. Therefore, claim 2 does not further limit parent claim 1.

All claims dependent thereon, namely claims 9-14, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

Additional clarification is requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 2, 6-7, 9-14 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the incorporation of the hand-held device into the claimed apparatus. See below for a discussion of this limitation.

Claims 6-7 recite the limitation "the pointer". There is insufficient antecedent basis for this limitation in the claim.

Additional clarification is requested.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 15-21, 23-28 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 15, this claim recites a "method".

The recitation "a computer system" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended

use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hiraio*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

This claim further recites "controlling and providing, by a master control file of a portability enabling program".

In applying the broadest and most reasonable interpretation in light of the specification and the level of ordinary skill in the art, Examiner interprets this limitation to recite software *per se*.

Insofar as "computer platforms" are concerned, Examiner recognizes that limitation is hardware; however, the structure required to control the interplay thereof need not be hardware based on the claim language, and is considered to be software *per se*.

Similarly, the remaining steps also do not require the particulars of a "machine". Therefore, any structure capable of performing the recited functionality could be reasonably interpreted to be enveloped by the claim, including software *per se* embodiments.

While Examiner recognizes that the claimed method produces file processing, Examiner submits that these limitations amount to mere data transformation, and do not produce a physical transformation.

Therefore, this claim fails the "machine or transformation" test, and is found to be directed towards nonstatutory subject matter.

All claims dependent thereon, namely claims 16-21, 23-28, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale as applied to claim 15 above, and incorporated herein.

Additional clarification is requested.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 1-5, 7, 9-19, 21, 23-33, 35, 37-42 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (5664109) and Official Notice.

As per claim 1, Johnson teaches a system (reads on "an apparatus") (Figure 1), comprising a computer system (Figure label 112) capable of:

(a) executing software to share patient records (reads on "portability enabling software") (column 2 line 13-26);

(b) storing a master patient record (reads on "master control file") (Figure 7 label 702);

(c) sharing (reads on "controlling and providing interoperability") medical records between a plurality of providers, wherein each provider need not adopt standard patient identifiers, medical formats, hardware, or software (reads on "computer platforms operating on disparate operating systems") (column 2 line 27-37).

Insofar as "the computer platforms including a personal computer, a hand-held device, and a network", Johnson need not teach these structural limitations because these limitations are not part of the claimed apparatus.

To the extent that these limitations are claimed, Examiner submits that the applied art need only teach that the known system is capable of communicating with a PC, a hand-held device, and a network.

The system of Johnson is capable of interfacing with any device that conforms to router network protocol (Figure 1 label 118). Therefore, Examiner submits that the disclosed system fully meets this limitation because any computer conforming to the prescribed router network protocol is capable of communicating with the system of Johnson.

Assuming that Applicant successfully amends the claim to encompass these limitations, Johnson teaches that the system is capable of:

(d) communicating with a plurality of subscriber computer systems (reads on "a personal computer") over a network (Figure 1 label 118).

Johnson does not teach "hand-held device".

Official Notice is taken that laptop computers and palmtop computers are old and well established in the art of network computing.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of the Official Notice within the embodiment of Johnson with the motivation of providing physicians with wireless computing platforms for convenience.

Johnson further teaches:

(e) the master patient record is capable of being used to serve a plurality of queries from the plurality of subscribers (reads on "interfaces with the disparate operating systems") (Figure 8 label 804-805);

(f) the master patient record is capable of mapping documents containing therein text and image data stored in a database to patient records (Figure 7);

(g) the system is capable of maintaining the database (Figure 7);

(h) receiving and storing the documents (Figure 4-6);

(i) storing (reads on "capture", "populate", "maintain") and retrieving the stored documents, wherein the documents are stored in their native formats (reads on "a plurality of image and text formats") (Abstract and throughout);

(j) the master patient record is capable of linking with a plurality of documents in any format (Figure 7, Abstract), and the plurality of subscribers (Figure 1);

(k) providing patient data (reads on "patient episode data") electronically over network (Figure 2).

Johnson further teaches that computer security is well known and should be applied to medical information (column 14 line 4-25).

Johnson further teaches that e-mail is also known in the art and may be used to communicate medical data (column 5 line 23-25).

Johnson further teaches receiving the transmitted patient data for storage (Figure 2 label 208).

Johnson does not teach "a secure file, transmitting the secure file as an e-mail attachment, retrieving the patient episode data from the secure file".

Official Notice is taken that sending a file via encrypted email is old and well established in the art of network security.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of the Official Notice within the embodiment of Johnson and the Official Notice with the motivation of providing an efficient form of file transfer that is easy for physicians to use.

The skilled artisan would have recognized the benefit that since physicians are already familiar with emailing, it would be easier to use email to submit patient data than to train physicians to use a different interface.

As per claim 2, the applied art need not teach any recited limitation because the hand-held device is not part of the claimed apparatus.

Assuming *arguendo* that Applicant successfully amends this limitation into the claimed apparatus, Examiner submits that any hand-held device within the scope of claim 1 and capable of communicating with the apparatus inherently executes "medical software" to communicate with the claimed apparatus.

Therefore, this claim is rejected for substantially the same rationale as applied to claim 1 above, and incorporated herein.

As per claim 3, Johnson teaches that the system is capable of accepting documents from the plurality of subscribers (reads on "interoperability to populate, maintain") (Figure 1) and retrieving information for the plurality of subscribers (Figure 8).

As per claim 4, Johnson teaches that the system is capable of maintaining the database (reads on "controls path and name of folder images, path to and name of the database, database field names, attributes, and locations on the folder image") (Figure 7, Figure 3).

Examiner considers a database table containing therein the documents to be a "folder".

As per claim 5, Johnson teaches storing the document with the original headings (reads on "each field name") (Figure 5 label ADMITTED WITH, MEDICAL SUMMARY, etc.).

As per claim 7, Johnson teaches linking the document identifier to the master patient identifier for display (reads on "name") (Figure 7 label 706).

Examiner also considers the foreign key linking to be a form of "pointer".

As per claim 9, Johnson teaches that the system is capable of storing medical data (Figure 7).

As per claim 10, Johnson teaches that the system is capable of allowing remote subscribers to review patient records (Figure 8).

As per claim 11, Johnson teaches that the system is capable of allowing remote subscribers to review patient records (reads on "health indicators") (Figure 8).

As per claim 12, this claim is rejected for substantially the same rationale as applied to claim 1 above, and incorporated herein.

Examiner considers encryption to be a form of "compresses".

As per claim 13, this claim is rejected for substantially the same rationale as applied to claim 1 above, and incorporated herein.

As per claim 14, Johnson teaches database triggers capable of notifying subscribers that new patient data is available for a specific patient of interest (Figure 4 label 422).

As per the set of claim(s): 15, 16, 17, 18, 19, 21, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 35, 37, 38, 39, 40, 41, 42, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, 2, 3, 4, 5, 7, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 21, 23, 24, 25, 26, 27, 28, respectively, and incorporated herein.

Claim(s) 6, 20, 34 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and Official Notice as applied to parent claims 4, 19, 32 above, and further in view of Amit (Federated Database Systems for Managing Distributed, Heterogeneous, and Autonomous Databases).

As per claim 6, Johnson does not teach "the pointer to and the name of the database indicates the database".

Amit teaches a federated database system, wherein schemas are mapped (reads on "the pointer to and the name") between databases (page 192 Section 1.1).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Amit within the embodiment of Johnson and the Official Notice with the motivation of providing increased availability, increased reliability, and improved access time (Amit; page 185 column 2 Section Distribution).

As per the set of claim(s): 20, 34, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 6, 20, respectively, and incorporated herein.

Response to Arguments

Applicant's arguments filed 10/17/2008 have been fully considered but they are not persuasive.

On page 8 Applicant asserts:

In the Office Action mailed April 23, 2008, claim 44 was objected to under 37 C.F.R. 1.75 as being a substantial duplicate of claim 1.

Page 2-3 of this Office Action reads as follows:

Applicant is advised that should claim 1 be found allowable, claim 44 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two

claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Since claim 1 was not allowed, no objection was imposed on claim 44.

Applicant's arguments with respect to claims 1, 15, 29 on page 8-11 have been considered but are moot in view of the new ground(s) of rejection.

On page 11 Applicant further asserts:

It is respectfully requested that the Examiner's assertion of Official Notice be withdrawn.

As discussed in the previous Office Action, Applicant failed to adequately traverse the Official Notice. Therefore, the noticed fact discussed therein is considered to be AAPA.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3626
12/07/2008

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626